Doc Code: AP.PRE.REQ

| PRE-APPEAL BRIEF REQUEST FOR REVIEW | Docket Number (Optional) |
|---|---|
| | ITL.0473US (P10020) |

| I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on January 17, 2006 | Application Number | Filed |
|---|---|---|
| | 09/678,549 | October 4, 2000 |
| Signature _Nancy Meshkoff_ | First Named Inventor | |
| Typed or printed name   Nancy Meshkoff | Rois O. Cordova | |
| | Art Unit | Examiner |
| | 2155 | Vitali A. Korobov |

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
    Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☐ attorney or agent of record.
Registration number _____

☒ attorney or agent acting under 37 CFR 1.34.   50,457

Registration number if acting under 37 CFR 1.34 _____
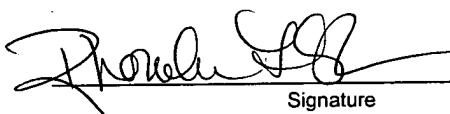
_Rhonda Sheldon (signature)_
Signature
Rhonda L. Sheldon
Typed or printed name

(713) 468-8880
Telephone number

January 17, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐   *Total of _____ forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | |
|---|---|---|
| In re Applicant: | § | Art Unit: 2155 |
| Rois O. Cordova | § | |
| | § | Examiner: Vitali A. Korobov |
| Serial No.: 09/678,549 | § | |
| | § | Atty Docket: ITL.0473US (P10020) |
| Filed: October 4, 2000 | § | |
| | § | Assignee: Intel Corporation |
| For: Peer to Peer Software | § | |
| Distribution System | § | Conf. No.: 5766 |

Mail Stop **AF**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW AND ACCOMPANYING ARGUMENT**

Sir:

Pursuant to the Pre-Appeal Brief Conference Pilot Program, please consider this a request for a pre-appeal brief conference with accompanying arguments.
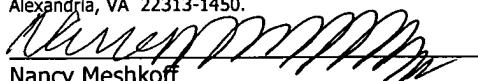
**REMARKS**

Claim 1 calls for forwarding a software package including: 1) instructions to install said package and 2) a list of addressees to a first processor-based system. The first processor-based system is enabled to automatically install the package and automatically forward the package, together with at least part of said list of addressees, to a second processor-based system.

The rejection of claim 1 is deficient because the examiner has not shown where the references disclose or suggest all of the limitations of claim 1 and/or the examiner has failed to show a proper motivation for making a modification in an obviousness rejection.

In the Office action, the examiner asserts that issuing an XFR command in Shepherd meets the limitation of forwarding a software package and that the "destination" parameter of the XFR command meets the limitation of sending (which is not a term found in claim 1) a list of addresses. Paper No. 20051005, page 3. But the XFR command merely *identifies* a software package that was *previously* sent to a terminal and *identifies* one terminal to receive the identified software package from the terminal that received the TRANSFER command. For example, in Shepherd, the management station 12 maintains a list of terminals. Column 3, lines 11-21. If there are terminals that have *previously received* the software package, the management station 12 may send a TRANSFER command to those terminals. Column 3, lines 41-58; Figure 4. Thus, the terminals receiving the TRANSFER command do not receive a software package and a list of addresses with the TRANSFER command.

Moreover, the only command disclosed by Shepherd that causes an identified software package to be sent is the SEND command, which has the format SEND(Filename). Column 3, lines 32-38. Notably, the SEND command does not include a "Destination" parameter. Thus, when a software package is sent in Shepherd, it is not accompanied by a list. This is believed to be true whether the management station or a transferring terminal sends a software package. For example, the management station sends a RECEIVE command and then a SEND command to cause the software package to be sent to the terminals that received the RECEIVE command. Column 3, lines 25-37. Similarly, after receiving a TRANSFER command, the transferring terminal sends a RECEIVE command to the terminal specified to receive the software package. Column 4, lines 1-21. Thereafter, the "*software package* is then transferred by the agent terminal to the specified terminal." *Id.* (emphasis added). Because the TRANSFER command merely *identifies* a software package already on a terminal and *identifies* a terminal to receive

2

the software, and because Shepherd sends *a software package* from one terminal to another, actual forwarding from the agent terminal to the specified terminal is believed to be by a SEND command. Comparing block 92 to block 128, in block 92 the software is *transferred* via the SEND command, and in block 128 the software package is *transferred* to the specified terminal. Shepherd does not disclose that the TRANSFER command does more than merely identify, such as *for* transfer. Again, the only command that Shepherd specifically associates with actual sending of the software package is the SEND command, which does not include a destination parameter. Taken together, it is submitted that Shepherd does not forward a software package that includes a list of addresses.

This contention is supported by Shepherd's example. In Shepherd's example, a software package is to be distributed to 1000 terminals. Column 4, lines 31-61. In the first hour of distribution, the management station sends the software package to 10 terminals, $T_0$ to $T_9$. *Id.* In the second hour, the management station commands those terminals $T_0$ to $T_9$ to distribute to terminals $T_{10}$ to $T_{19}$ respectively while the management station distributes software to another ten terminals, $T_{20}$ to $T_{29}$. *Id.* Note that the terminals that have the software package do not have a direction or place to forward to until commanded to do so via XFR and that there is a one-to-one correspondence between the sending and receiving terminals. This scheme is continued in the third hour, with terminals $T_0$ to $T_{29}$ being commanded to distribute the received software to terminals $T_{30}$ to $T_{59}$ respectively. *Id.* From this example it is clear that the terminals receiving the TRANSFER command have previously received the software program, have no instruction to distribute or place to forward until receipt of the TRANSFER command, and distribute the software to only *one* other terminal. Thus, Shepherd does not disclose sending a software package with a list, and if it is (wrongly) determined that Shepherd teaches sending destination information as *part of* the software package, which it is maintained that he does not, this still does not disclose *a list* as argued by the examiner.

Given that Shepherd does not disclose what the examiner asserts that it does, there is no suggestion or motivation to modify Shepherd. That is, Shepherd discloses a list that is maintained by a management station and that his distribution system would reduce distribution from 100 hours to seven hours. Column 4, lines 57-61. Thus, there is simply no compelling reason to modify Shepherd to include a node list per Gilbert. Even if there were, which there is

not, the modification still would not disclose forwarding a software package *including* a list of addresses to a first processor-based system as discussed above.

Shepherd also does not disclose a first processor-based system that is enabled to automatically install the package and *automatically forward the package, together with at least part of said list of addressees*, to a second processor-based system. As explained above, in Shepherd, a terminal must first receive the software package before it may receive a TRANSFER command. Column 3, lines 21-51. Therefore, the software package is not automatically forwarded from one terminal to another. In fact, when a terminal receives the software package, it has no information regarding a subsequent destination. Although the examiner acknowledges that Shepherd does not disclose automatically forwarding, there is no further consideration of this limitation in the rejection. Paper No. 20051005, pages 4-5. For this reason alone, the rejection is deficient. Furthermore, the examiner has not provided a motivation to modify Shepherd to automatically forward. That is, Shepherd's terminals will not forward without being expressly told to do so by the management station; thus, modification of Shepherd is *not* merely making something automatic that was previously performed manually. In other words, Shepherd's operation depends upon instruction from the management station, after the management station has determined that there are terminals that are without the software package, and not by a user command to forward. Column 3, lines 12-17 and 59-67.

Even if there were some suggestion to modify Shepherd, which there is not, Shepherd would have to be modified to such a degree that his invention would no longer be recognizable. But where proposed modifications change the principle of the operation of the prior art invention being modified, the teachings of the references are not sufficient to render the claims *prima facie* obvious. MPEP §2143.02 VI. THE PROPOSED MODIFICATIONS CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE, *citing In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). In Shepherd control of software distribution is maintained by a management station. Without instruction from the management station, Shepherd's individual terminals would not and could not transfer the software package to another terminal. Moreover, the individual terminals can only send the software package to one other terminal per TRANSFER command. Thus, Shepherd does not "disclose the

invention substantially as claimed," and to modify Shepherd to do so would be a vast departure from the spirit of his invention.

As shown above, the examiner has failed to establish *prima facie* obviousness with respect to independent claim 1 (and claims dependent thereon). On the same basis, *prima facie* obviousness has not been established for independent claims 11 and 21 and their respective dependent claims.

The application is believed to be in condition for allowance. A decision in favor thereof is requested.

Respectfully submitted,

Date:  January 17, 2005

Rhonda L. Sheldon, Reg. No. 50,457
TROP, PRUNER & HU, P.C.
8554 Katy Freeway, Ste. 100
Houston, TX  77024
713/468-8880 [Phone]
713/468-8883 [Fax]

Attorneys for Intel Corporation